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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,868	04/06/2001	Hironobu Sakaguchi	P20824	3212
7055	7590	08/11/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,868

Applicant(s)

SAKAGUCHI, HIRONOBU

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-18 is/are rejected.
- 7) ☒ Claim(s) 3 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7-5-01&6-28-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 13-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. These claims fail the infringement test of MPEP § 608.01(n).III: Mere possession of the subject computer program product or data storage medium would infringe on claims 13-18 without also infringing on the base claim. Applicant is required to cancel the claim(s) or rewrite the claim(s) in independent form.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13, 15, 16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since a system/apparatus invention is judged by its structure, not its function, it is not clear what is meant by "achieving the functionality" of the base claims.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-7, and 9-18 are rejected under 35 U.S.C. 103(a) as being obvious over LaPlante (Computerworld, 5 April 1999).
6. LaPlante teaches (independent claims 1, 6 and 10) a network system, a control method for a home appliance, and said appliance connected to a network, the network system comprising a network interconnecting at least one appliance (*refrigerator*) having a data

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output system (the refrigerator's *barcode scanner, communications port and Internet connection*, p. 52 col. 3-4) that outputs information, wherein the home appliance comprises a product identification system and a transmission system the refrigerator's *barcode scanner, communications port and Internet connection*, p. 52 col. 3-4); and an interpreting system that interprets lifestyle conditions of the appliance user (p. 53, col. 2, para. 5-8 as marked; the "DRO" feature in col. 3; and the col. 4 discussion of consumer targeting), and a transmission/receiving system that sends/receives advertising and sales promotion information to the home appliance user (*electronic coupons and promotions* at the end of para. 5, and the discussion of automatically filling the refrigerator at para. 3 of col. 1. p. 53).

7. LaPlante does not explicitly teach a server system for communicating data with the home appliance. However, since the structure recited in the reference is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that the appliance transmits data over the Internet to something, and that something reads on a server system.
8. LaPlante does not teach that the advertising/sales promotion information is sent to, and output/displayed at the appliance. Because the reference invention teaches that the appliance is a point of sale, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of LaPlante that the advertising/sales promotion information is sent to, and output/displayed at the appliance.
9. LaPlante does not teach (claim 6) that the home appliance will be placed where it is used by a user and the consumption data is input on the side of the appliance. Since the principal common purpose of buying an appliance (refrigerator) is to use it, it is surely obvious to place the home appliance where it is used by a user. Because some users may prefer keypad input to scanner input, and because the appliance side is a convenient place to put the input keypad, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of LaPlante that the consumption data is input on the side of the appliance.
10. LaPlante also teaches at the citations given above claims: 2, 7 and 11; and claims 5, 9 and 12. LaPlante also teaches claims 13-18 inherently.
11. LaPlante does not teach (claim 4) optimized information. Official notice is taken (MPEP § 2144.03) that ad targeting was common, at the time of the instant invention. Ad targeting

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reads on the sending of optimized information. Because targeting improves sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add targeted/optimized information to the teachings of LaPlante.

***Allowable Subject Matter***

12. Claims 3 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
13. Allowance is further dependent on successful vetting by a "second pair of eyes". Examiner has performed every search deemed reasonable, but does not ask for review of allowable subject matter until applicant indicates willingness to put the application into condition for allowance.
14. The following is an examiner's statement of reasons for the indication of allowable subject matter: the closest prior art, LaPlante, does not teach or suggest compensating the home appliance user commensurate to power consumption of the appliance. Whereas compensating the user for receiving ads would be obvious, tying this compensation to power consumption of the appliance is not. Kikuchi et al. (US 20020128853A1) teaches this inventive feature (para. [0048]), but Kikuchi et al. is not prior art.

***Request for Information under 37 CFR § 1.105***

15. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal*

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fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.

17. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

18. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

ANG  
2 July 2004



Donald L. Champagne  
Primary Examiner  
Art Unit 3622

***Request for Information under 37 CFR § 1.105***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. **Scope of the requirement: Please provide any prior art of which you are aware that teaches or suggests compensating the home appliance user commensurate to the power consumption of the appliance.** For foreign documents or public use, "prior art" means any document published or public use before the US filing date of the instant application, 6 April 2001.
2. If the document is written in a language other than English, please mark the section(s) of the teaching or suggestion and provide a translation into English of said section(s).
3. **Why the requirement is reasonably necessary:** The examiner's search and experience suggest that the requested prior art, if it exists, will be written in Japanese, and that the potential inventive feature will be a minor part of said Japanese document(s). For example, Kikuchi et al., discussed in the body of this Office action (para. 14), was found by the examiner only because it is written entirely in English.
4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement.
5. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.
6. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

  
ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600